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D9 holder 8 as shown in FIGS. 22 and 23. Thus, the enclosing member 5 is accommodated within the holder 8,

Please replace the last paragraph on page 26 of the specification (see lines 25-27 on page 26) with the amended paragraph set forth below.

D15 In the first to fourth and sixth embodiments, the enclosing member has two hinges. However, a larger number of hinge portions may be provided. The above-described

Appendix B, which is enclosed herewith, shows how the originally filed specification was amended to produce the amended paragraphs set forth above. In Appendix B, the portions being added are underlined; and the portions being deleted are enclosed in brackets.

REMARKS

This supplemental preliminary amendment supplements the preliminary amendment that was filed with a certificate of mailing on May 4, 2001.

Hereinafter, the claims that are pending prior to the entry of the amendments in this supplemental preliminary amendment are called

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"currently pending claims." This supplemental preliminary amendment cancels currently pending Claims 17, 18, and 33; amends currently pending Claims 4, 7, 21-25, and 31; and adds new Claims 34-53. Upon amendment, the above-identified application will have two independent claims (amended Claims 4 and 7) and 37 total claims (amended Claim 4, currently pending Claims 5 and 6, amended Claim 7, currently pending Claims 19 and 20, amended Claims 21-25, currently pending Claims 26-30, amended Claim 31, and new Claims 34-53). The Applicants previously paid for four independent claims and 20 total claims. Therefore, enclosed herewith is a check for the fee for 17 excess total claims.

Support for amending currently pending Claim 4 can be found in, inter alia, the originally filed version of Claim 4, lines 17-20 on page 9 of the specification, lines 6-11 on page 10 of the specification, lines 3-6 on page 23 of the specification, and Figures 5-7 and 11 in the above-identified U.S. application.

Support for amending currently pending Claim 7 can be found in, inter alia, the originally filed version of Claim 7, lines 22-24 on page 14 of the specification, lines 5-19 on page 18 of the specification, the second paragraph on page 19 of the specification, lines 11-13 on page 20 of the specification, and Figure 8 in the above-identified U.S. application.

Support for amending currently pending Claim 21 can be found in, inter alia, lines 11-13 on page 20 of the specification.

Support for new Claims 34, 43, and 49 can be found in, inter alia, lines 6-10 on page 21 of the specification and the sentence bridging pages 22 and 23 of the specification of the above-identified U.S. application.

Support for new Claims 35, 36, 44, 45, 50, and 51 can be found in,



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inter alia, lines 12-20 on page 9 of the specification, lines 18-24 on page 17 of the specification, the last three lines on page 26 of the specification, and Figures 5-7 of the above-identified U.S. application.


Support for new Claims 37, 38, 46, 47, 52, and 53 can be found in, inter alia, lines 6-10 on page 21 of the specification, the sentence bridging pages 22 and 23 of the specification, lines 12-20 on page 9 of the specification, lines 18-24 on page 17 of the specification, the last three lines on page 26 of the specification, and Figures 5-7 of the above-identified U.S. application.

Support for new Claim 39 can be found in, inter alia, the originally filed version of Claim 17. Support for new Claim 40 can be found in, inter alia, the originally filed version of Claim 17 and Figure 4 of the above-identified U.S. application.

Support for new Claim 41 can be found in, inter alia, lines 22-24 on page 14 of the specification, lines 5-19 on page 18 of the specification, the second paragraph on page 19 of the specification, and lines 11-13 on page 20 of the specification of the above-identified U.S. application.

Support for new Claims 42 and 48 can be found in, inter alia, the originally filed version of Claim 4, lines 17-20 on page 9 of the specification, lines 6-11 on page 10 of the specification, lines 3-6 on page 23 of the specification, and Figures 5-7 in the above-identified U.S. application.

In items 1 and 2 of the June 26, 2000 Office Action, the Examiner rejects then-pending Claims 4, 5, 7, 22, 26, 27, and 30 for allegedly being anticipated by Nakajima, et al.'s U.S. Patent No. 5,496,328. In items 3-5 of the June 26, 2000 Office Action, the Examiner rejects then-pending Claims 6, 17-21, 23-25, 28, 29, 31,



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and 32 for allegedly being obvious over the Nakajima patent in view of Eagles, et al.'s U.S. Patent No. 5,616,148. The Applicants traverse these rejections because the claims are novel and nonobvious over the prior art for the reasons set forth below.

Independent amended Claim 4 claims an insertion device comprising an enclosing member having an open position and a closed position, wherein the enclosing member engages at least the peripheral edge of the deformable intraocular lens when the enclosing member is in the open position, and wherein the optical portion of the deformable intraocular lens substantially does not come into contact with the enclosing member when the enclosing member is in the open position. Thus, the claimed insertion device facilitates sanitation and sterility by reducing the amount of time during which the optical portion of the intraocular lens contacts the enclosing member. Furthermore, because the optical portion of the intraocular lens substantially does not come into contact with the enclosing member when the enclosing member is in the open position, the insertion device claimed in amended Claim 4 enables the user to apply lubricant to the area of the enclosing member that is below the optical portion when the intraocular lens is held in the enclosing member in the open position.

By contrast, the prior art discloses insertion devices wherein the optical portion of the lens substantially contacts the enclosing member. For example, the Nakajima patent discloses an inserting device comprising an opening/closing mechanism 23 having a movable pressing flange 31, a movable half sleeve 28, a stationary pressing plate 30, a stationary half sleeve 27, and a hinge 29 that connects the movable half sleeve 28 with the stationary half sleeve 27 (see Figure 3 and the last paragraph of column 4 of the Nakajima patent). Thus, when the opening/closing mechanism 23 is in an open position and the intraocular lens 1 illustrated in Figure 4 of the Nakajima patent is positioned in the opening/clos-



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ing mechanism 23, the optical part 2 of the intraocular lens 1 will substantially contact the opening/closing mechanism 23 (e.g., the optical part 2 of the intraocular lens 1 will substantially contact the hinge 29). This drawback is most clearly illustrated in Figure 30 of the Applicants' above-identified U.S. application. Figure 30, which is labelled "prior art," shows an enclosing member 5 that is similar to the opening/closing mechanism 23 in the Nakajima patent. Figure 30 also shows how the optical portion of the intraocular lens 1 substantially contacts the enclosing member 5 (i.e., the optical portion substantially contacts the hinge portion 6).

In conclusion, independent amended Claim 4 is novel and nonobvious over the prior art because the prior art does not teach or suggest an insertion device having an enclosing member wherein, as claimed in amended Claim 4, the optical portion of the deformable intraocular lens substantially does not come into contact with the enclosing member when the enclosing member is in the open position.

Independent amended Claim 7 is also novel and nonobvious over the prior art. Amended Claim 7 claims an insertion device comprising a body and a holder, wherein the body has an enclosing member and the holder is slidably connected to the body, and wherein the holder closes the enclosing member from the open position to the closed position when the holder is slid toward or over the enclosing member. Thus, a user of the insertion device claimed in amended Claim 7 can, without touching the enclosing member with his fingers, close the enclosing member from the open position to the closed position simply by sliding the holder toward or over the enclosing member.

By contrast, the Nakajima patent discloses an inserting device comprising an opening/closing mechanism 23 having a movable pressing flange 31, a movable half sleeve 28, a stationary pressing



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plate 30, a stationary half sleeve 27, and a hinge 29 that connects the movable half sleeve 28 with the stationary half sleeve 27 (see Figure 3 and the last paragraph of column 4 of the Nakajima patent). The Nakajima patent discloses an opening/closing mechanism 23 having flanges 31 and 32 because a user of Nakajima's inserting device must use his fingers on flanges 31 and 32 to close the opening/closing mechanism 23. Thus, independent amended Claim 7 is novel and nonobvious because the prior art does not teach or suggest an insertion device comprising a body and a holder wherein, as claimed in amended Claim 7, the holder closes the enclosing member from the open position to the closed position when the holder is slid toward or over the enclosing member.

The subclaims (i.e., currently pending Claims 5, 6, 19, and 20, amended Claims 21-25, currently pending Claims 26-30, amended Claim 31, and new Claims 34-53) are nonobvious over the prior art because they are each directly or indirectly dependent on a nonobvious base claim (independent amended Claim 4 or 7). The subclaims are further nonobvious over the prior art because the prior art does not teach or suggest the particular features claimed in these subclaims.

For example, new Claims 35-38, 44-48, and 50-53 are further nonobvious over the prior art because these new claims call for an insertion device comprising an enclosing member having two hinge portions, which are not disclosed or suggested by the prior art. In addition, new Claim 41 is further nonobvious over the prior art because the claimed insertion device, unlike the devices disclosed or suggested by the prior art, has a holder that gradually closes the enclosing member from the open position to the closed position and then maintains the enclosing member in the closed position when the holder is slid toward or over the enclosing member.

For the foregoing reasons, amended Claim 4, currently pending



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Claims 5 and 6, amended Claim 7, currently pending Claims 19 and 20, amended Claims 21-25, currently pending Claims 26-30, amended Claim 31, and new Claims 34-53 are novel and nonobvious over the prior art. Furthermore, this supplemental preliminary amendment amends the specification of the above-identified U.S. application to correct various minor grammatical or spelling errors.

Therefore, the above-identified U.S. application is in condition for allowance. Favorable reconsideration of the amended application is respectfully requested. Allowance of the claims at an early date is solicited.

This supplemental preliminary amendment cancels currently pending Claims 17, 18, and 33; amends currently pending Claims 4, 7, 21-25, and 31; and adds new Claims 34-53. The cancellations, amendments, and additions described in the preceding sentence were done to claim the scope of the invention that the Applicants elect to claim and were not done to overcome the prior art and were not done to overcome rejections under 35 U.S.C. § 112. The cancellation, amendments, and additions described in the first sentence of this paragraph shall not be considered necessary to overcome the prior art and shall not be considered necessary to overcome rejections under 35 U.S.C. § 112.

The Applicants reserve the right to seek protection for any unclaimed subject matter either subsequently in the prosecution of the present case or in a divisional or continuation application.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to Deposit Account No. 12-0415. In particular, if this preliminary amendment is not timely filed, then the Commissioner is authorized to treat this preliminary amendment as including a petition to extend the time period pursuant to 37 C.F.R. 1.136(a) requesting an extension of time of



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the number of months necessary to make this preliminary amendment timely filed; and the petition fee due in connection therewith may be charged to deposit account No. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C., 20231 on

June 22, 2001
(Date of Deposit)

JOHN PALMER
(Name of Applicant, Assignee
or Registered Representative)

(Signature)

(Date)

Respectfully submitted,



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